

**Response to the Examiner's withdrawal of claims**

The Examiner has withdrawn claims 1-10 and 25-29 from further consideration for purportedly being drawn to an independent and distinct invention. Applicants respectfully disagree. However, in the interest of furthering prosecution, claims 1-10 and 25-29 have been newly canceled. Applicants hereby reserve the right to prosecute the subject matter of claims 1-10 and 25-29 in future applications.

**Response to the objections to the claims**

Claims 11-18 and 23-24 were objected to for depending from non-elected claims. Claims 11-18 and 23-24 have been canceled. Newly added claims 30-44 have been drafted to eliminate these dependencies and as such obviate this objection.

Claims 11-18 and 23-24 were objected to for being multiple dependent claims which depend on other multiple dependent claims. Newly added claims 30-44 have been drafted to eliminate these multiple dependencies and as such obviate this objection.

Claim 21 was objected to for failing to further limit the subject matter of the previous claim. Claim 21 has been canceled, as such this objection is moot.

**Response to the rejection under 35 U.S.C. 102(b)**

Claim 19 stands rejected under 35 U.S.C. 102(b), for purportedly being anticipated by Smith *et al.* (EP 0779363 A2)

Claim 19 has been canceled. As such, the rejection under 35 U.S.C. 102(b) will be addressed as it applies to newly added claims 30-41.

Newly added claims 30-41 are directed to starch extracted from a plant that has been stably transformed with two genes, each gene encoding a starch synthase enzyme.

Smith *et al.* teach the isolation and characterization of a gene encoding a starch synthase enzyme. Smith *et al.* also teach the production of transgenic plants comprising a heterologous starch synthase gene and the starch produced by these plants. Smith *et al.* provides no teaching, however, regarding plants stably transformend with **least two** genes encoding starch synthase enzymes or the starch produced by these plants. As such, Smith *et al.* does not anticipate claims

30-41, as Smith *et al.* does not teach every limitation of each claim. Furthermore, Smith *et al.* do not provide motivation to accomplish the invention as claimed. Therefore, Applicants respectfully request that this rejection does not apply to the currently pending claims.

### **Response to the rejection under 35 U.S.C. 103**

Claims 19-22 stand rejected under 35 U.S.C. 103(a), for purportedly being obvious over Haynes *et al.* (US 6,013,299)

Claims 19-22 have been canceled. As such, the rejection under 35 U.S.C. 103(a) will be addressed as it applies to newly added claims 30-41.

The Examiner contends that Haynes *et al.* teach high amylose starches which differ from the starch of claims 19-22 only in that Haynes *et al.* do not disclose the viscosity or endotherm onset temperatures.

Newly added claims 30-41 are directed to starch extracted from a plant that has been stably transformed with two genes, each gene encoding a starch synthase enzyme. Haynes *et al.* do not teach or suggest the invention of claims 30-41. The teaching of Haynes *et al.* is limited to the conventional production of starches through methods comprising a gelatinization stage, nucleation/propagation stage and a heating stage. They provide no teaching or reference to methods of producing starch through the use of transgenic plants. As such, Haynes *et al.* does not teach or suggest the invention of claims 30-41. As for the Examiner's concerns regarding the inherent characteristics of the starch taught by Haynes *et al.*, this concern is misplaced as the starch of the instant invention is produced by an entirely different method than the starch taught by Haynes *et al.* and absent any specific teachings, would not be expected to have identical physical properties. As such, claims 30-41 are not obvious over Haynes *et al.* Therefore, Applicants respectfully request that this rejection not be applied to the currently pending claims.

### **Conclusion**

The foregoing amendments and remarks are being made to place the application in condition for allowance. Applicants respectfully request reconsideration and the timely allowance of the pending claims. A favorable action is awaited. Should the Examiner find that

an interview would be helpful to further prosecution of this application, he is invited to telephone the undersigned at his convenience.

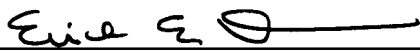
If there are any additional fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

**MORGAN, LEWIS & BOCKIUS LLP**

Date: December 13, 2002

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**In the specification:**

The title has been replaced with the following:

**STARCH OBTAINABLE FROM MODIFIED PLANTS**

**In the claims:**

Claims 1-29 have been cancelled and new claims 30-41 have been added.